



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(MBHB 02-090-Z)

In the Application of:

Bakthavatchalam et al.

Serial No: 10/799,286

Filed: March 12, 2004

For: Capsaicin Receptor Ligands

Group Art Unit: 1614

Examiner: Kevin E. Weddington

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

1. We are transmitting herewith the attached papers for the above-identified new patent application:
 - a. ☒ Transmittal letter with duplicate
 - b. ☒ Supplemental Information Disclosure Statement with twenty-one (21) references
 - c. ☒ PTO Form 1449
 - d. ☒ Return Postcard
2. ☒ No additional fee is required.
3. **GENERAL AUTHORIZATION TO CHARGE OR CREDIT FEES:** Please charge any additional fees or credit overpayment to Deposit Account No. **13-2490**. A duplicate copy of this sheet is enclosed.
4. **CERTIFICATE OF MAILING UNDER 37 CFR § 1.8:** The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as "First Class Mail" in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on this 1st day of December, 2004.

Respectfully submitted,

By:

Steven J. Sarussi
Registration No. 32,784

references. This Statement is not a representation that the cited references have effective dates early enough to be “prior art” within the meaning of 35 U.S.C. sections 102 or 103.

Should the Examiner desire a translation of any non-English language document listed below, Applicant will provide an English translation upon request.

CITED REFERENCES

U.S. Patents

1. U.S. Patent No. 4,439,606 issued March 1984.
2. U.S. Patent No. 4,450,272 issued May 1984.
3. U.S. Patent No. 4,659,710 issued April 1987.
4. U.S. Patent No. 5,021,438 issued June 1991.
5. U.S. Patent No. 5,354,747 issued October 1994.
6. U.S. Patent No. 5,430,033 issued July 1995.
7. U.S. Patent No. 5,442,064 issued August 1995.
8. U.S. Patent No. 5,461,047 issued October 1995.
9. U.S. Patent No. 5,756,504 issued May 1998.
10. U.S. Patent No. 5,789,412 issued August 1998.
11. U.S. Patent No. 5,792,768 issued August 1998.
12. U.S. Patent No. 5,840,720 issued November 1998.
13. U.S. Patent No. 6,028,195 issued February 2000.
14. U.S. Patent No. 6,169,088 issued January 2001.
15. U.S. Patent No. 6,329,395 issued December 2001.

Foreign Documents

16. EP 0 407 200 A published January 1991.
17. EP 0 882 717 A1 published December 1998.
18. EP 0 974 573 A published January 2001.
19. EP 11 122 242 A1 published August 2001.
20. WO 94/29286 published December 1994.
21. WO 96/01820 published January 1996.
22. WO 96/02525 A1 published February 1996.
23. WO 96/21648 published July 1996.
24. WO 98/00402 published January 1998.
25. WO 98/14431 published April 1998.
26. WO 98/20867 published May 1998.
27. WO 99/07672 published February 1999.
28. WO 99/51582 published October 1999.
29. WO 99/64394 published December 1999.
30. WO 00/27822 published May 2000.
31. WO 00/52001 published September 2000.
32. WO 00/63171 published October 2000.
33. WO 02/05819 published January 2002.

Other Documents

34. Pan and Sun, Tetrahedron Letter (1998) 39: pp. 9505-9508.
35. Mokrosz et al., (1992) J. Med. Chem. 35:2369-74-note compound 31 on page 2370.
36. Prasad et al. (1968) J. Med. Chem. 11:1144-50 note table 4.

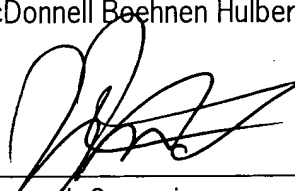
Also, enclosed is a copy of the European Search Report in which the above-listed references were cited during the prosecution of a corresponding PCT application.

In accordance with MPEP Sections 609 and 707.05(b), it is requested the document cited (including any cited in applicant's specification which is not repeated on the attached Form PTO-1449) be given thorough consideration and that it be cited of record in the prosecution history of the present application by initialing on Form PTO-1449. Such initialing is requested even if the Examiner does not consider a cited document to be sufficiently pertinent to use in a rejection, or otherwise does not consider it to be prior art for any reason, or even if the Examiner does not believe that the guidelines for citation have been fully complied with.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff LLP

Date: 12/1/04

By:



Steven J. Sarussi
Registration No. 32,784

FORM PTO-1449
(Rev. 2-32)

U.S. Department of Commerce
Patent and Trademark Office

Atty. Docket No.

02-090-Z

Serial No.

10/798,286

INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

(Use several sheets if necessary)

Applicant:

Bakthavatchalam et al.

Filing Date:

March 12, 2004

Group:

1614

U.S. PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date if Appropriate
	1	4,439,606	3/27/1984	Du et al.			
	2	4,450,272	5/22/1984	Du et al.			
	3	4,659,710	4/21/1987	Susumu et al.			
	4	5,021,438	6/04/1991	Bodo et al.			
	5	5,354,747	10/1994	Hansen			
	6	5,430,033	7/1995	Cliffe et al.			
	7	5,442,064	8/15/1995	Pieper et al.			
	8	5,461,047	10/24/1995	Hansen Jr., et al.			
	9	5,756,504	5/26/1998	Bock et al.			
	10	5,789,412	8/4/1998	Halazy et al.			
	11	5,792,768	8/11/1998	Kalagowski et al.			
	12	5,840,720	11/24/1998	Ing-Jun			
	13	6,028,195	2/22/2000	Cho et al.			
	14	6,169,088	1/02/2001	Matsuno et al.			
	15	6,329,395	12/11/20001	Dugar et al.			

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication.

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FOREIGN PATENT DOCUMENTS

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							Yes	No
16		0 407 200 A1	09.01.1991	EP				
17		0 882 717 A1	09.12.1998	EP				
18		0 974 573 A1	26.01.2000	EP				
19		1 122 242 A1	08.08.200	EP				
20		WO 94/29286	22.12.1994	PCT				
21		WO 96/01820	05.07.1995	PCT				
22		WO 96/02525 A1	20.07.1995	PCT				
23		WO 96/21648	10.01.1996	PCT				
24		WO 98/00402	28.06.1997	PCT				
25		WO 98/14431	01.10.1997	PCT				
26		WO 98/20867	14.11.1997	PCT				
27		WO 99/07672	24.07.1998	PCT				
28		WO 99/51582	31.03.1999	PCT				
29		WO 99/64394	07.06.1999	PCT				
30		WO 00/27822	04.11.1999	PCT				
31		WO 00/52001	03.03.2000	PCT				

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		Document Number	Date	Country	Class	Subclass	Translation	
							Yes	No
	32	WO 00/63171	20.04.2000	PCT				
	33	WO 02/05819 A1	13.07.2001	PCT				

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc).

34	Pan and Sun, Tetrahedron Letters (1998) 39:pp. 9505-9508.
35	Mokrosz, et al., J. Med. Chem. (1992) 35:2369-2374 note compound 31 on pate 2370..
36	Prasad et al., J. Med Chem. (1968) 11:1144-1150 note table 4.

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